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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,797	12/14/2001	Steven M. Bessette	45112-200	1638

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EXAMINER

AFREMOVA, VERA

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/014,797

Applicant(s)

BESSETTE ET AL.

Examiner

Vera Afremova

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7,17,20 and 140-145 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,7,17,20 and 140-145 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/27/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1, 7, 17, 20 and 140-145 as amended (2/21/2006) are pending and under examination in the instant office action.

Claim Rejections - 35 USC § 112

Claims 1, 7, 17, 20 and 140-145 as amended are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 7, 17, 20 and 141-145 as amended recite the use of “inert carrier”. The claimed “inert” carriers are mineral oil, benzyl alcohol, citronellal, limonene, safflower oil, soybean oil, and sesame oil (claims 7, 17, 20, 141-145). The applicants’ definitions of the claimed term “inert carrier” are confusing and indefinite.

At one instance applicants definite the term “inert” carrier as materials that facilitate application of active components (page 16, lines 26-30). The list of inert carriers includes generic alcohols and generic “botanical oils” including soy oil and some “light oils” (page 17, lines 8, 11 and 15). However, at the other instance applicants definite botanical oils or plant essential oils as active ingredients having pesticidal effects as disclosed by applicants (page 16, lines 3-5). The pesticidally active essential oils or botanical oils (page 12, line 26) include benzyl alcohol (page 12, line 32), citronellal, limonene, safflower or “starflower” oil, soybean oil, and sesame oil (page 13, lines 3, 18, 34). The disclosed list of pesticidally active oils also include mineral oil (page 13, line 23). Thus, the same compounds are regarded by applicants as both active and inert materials. Therefore, the applicants definitions of “inert” materials and of pesticidally “active” materials are at the very least very confusing and, thus, indefinite.

Claim Rejections - 35 USC § 112

New matter

Claims 7, 17, 20 and 140-145 as amended are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Insertion of the limitation drawn to a pesticidal composition that “consists of” only 3 ingredients that are rosemary oil, wintergreen oil and only one “inert” ingredient that is either mineral oil or benzyl alcohol or citronellal or limonene or safflower oil or soybean oil or sesame oil has no support in the as-filed specification.

The insertion of this limitation is a new concept because it neither has literal support in the as-filed specification by way of generic disclosure, nor are there specific examples of the newly limited compositions that would show possession of the concept of the use of only 3 ingredients in the pesticidal composition.

The generic disclosure is broad and it allows for incorporation of any and all essential oils, carriers and diluents, etc. The applicants’ definitions of “active” and “inert” materials are confusing and indefinite.

The particular disclosure is missing the description of a composition and its effects wherein the composition “consist of” rosemary oil, wintergreen oil and mineral oil (claims 7 and 20). The particular disclosure is missing the description of a composition and its effects wherein the composition “consist of” rosemary oil, wintergreen oil and benzyl alcohol (claims 7 and

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140). The particular disclosure is missing the description of a composition and its effects wherein the composition “consist of” rosemary oil, wintergreen oil and citronellal (claims 7 and 141).

The particular disclosure is missing the description of a composition and its effects wherein the composition “consist of” rosemary oil, wintergreen oil and limonene (claims 7 and 142). The particular disclosure is missing the description of a composition and its effects wherein the composition “consist of” rosemary oil, wintergreen oil and safflower oil (claims 7 and 143). The particular disclosure is missing the description of a composition and its effects wherein the composition “consist of” rosemary oil, wintergreen oil and soybean oil (claims 7 and 144). The particular disclosure is missing the description of a composition and its effects wherein the composition “consist of” rosemary oil, wintergreen oil and sesame oil (claims 7 and 145).

Thus, the claimed composition(s) have no support in the as-filed specification. This is a matter of written description, not a question of what one of skill in the art would or would not have known. The material within the four corners of the as-filed specification must lead to the generic concept. If it does not, the material is new matter. Declarations and new references cannot demonstrate the possession of a concept after the fact. Thus, the insertion of the limitation drawn to a pesticidal composition that “consists of” only 3 ingredients that are rosemary oil, wintergreen oil and only one “inert” ingredient is considered to be the insertion of new matter for the above reasons.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Claims 1, 7, 17, 20, 141 and 142 as amended remain/are rejected under 35 U.S.C. 102(b) as being anticipated by DE 524 383 in view of Merck (Encyclopedia of chemicals, drugs and biologicals. 1996).

Claims are directed to a pesticidal composition consisting of an "inert" carrier and a pesticidally active ingredient that consists of rosemary oil and wintergreen oil. Some claims are further drawn to the use of "inert" carriers selected from mineral oil, citronellal and/or limonene. Some claims are directed to the use of equal amounts of rosemary and wintergreen oils in the composition.

DE 524 383 teaches a pesticidal composition for combating cockroaches, bugs, etc. (see English abstract and official translation pages 2-3) wherein the composition comprises pesticidally acceptable carriers and a pesticidally active ingredient that consists of rosemary oil and wintergreen oil in equal amounts. The composition of the cited patent comprises equal amounts of rosemary oil (34 g) and wintergreen oil (34 g), for example: see col. 1, lines 27 and 30; see translation pages 2-3. The list of carriers includes mineral oil (petroleum) and lemon oil that comprises citronellal and/or limonene. The citronellal and limonene are found in lemon oil in view of Merck disclosure (pages 393 and 938). Thus, the cited document discloses the same carrier ingredients that are regarded by applicants as "inert" carriers within the meaning of the claims and in the light of specification uncertain definitions. The cited patent is considered to anticipate the claimed invention as amended because it discloses an identical composition consisting of 2 major groups of components that are 1) "inert" carrier(s) and 2) pesticidally active ingredient consisting of equal amounts of rosemary oil and wintergreen oil.

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The fact that the cited patent DE 524 383 discloses the use of some additional components including oils, carriers and/or solvents does not distinguish the referenced composition from the presently claimed composition that requires incorporation of some uncertain "inert" carrier in view of 112-2 issues. The additional components in the cited patent are oils, solvents, emollients, bases for aromatic compounds and subcomponents that fall within the meaning of inert carriers that facilitate application of active ingredients. For example: linseed oil is used as emollient and, thus, it is not different from a generic "inert" carrier as claimed; spirits and caustic potash solution (KOH) are solvents and, thus, they are not different from a generic "inert" carrier as claimed; benzene is naturally occurring in mineral oil and, thus, it is either present in the claimed mineral oil or it is not different from a generic "inert" carrier as claimed; anisol and pinene (turpentine oil) are used as bases for aromatic compounds and, thus, they are not different from a generic "inert" carrier as claimed; benzylaldehyde is used as solvent and, thus, it is not different from a generic "inert" carrier as claimed; although trichloroacetic acid, phenol and formaldehyde might be used as antiseptics or antimicrobials, they also function as solvents, facilitate delivery of dissolved "active" oils and, thus, falls within the meaning of "inert" carriers that facilitate delivery of "active" oils within the meaning of the claims and when read in the light of applicants' definitions.

Therefore, the additional components besides rosemary and wintergreen oils in the composition the cited patent fall within the meaning of the presently claimed "inert carrier".

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Claims 1, 7, 17, 20 and 140-145 as amended remain/are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 524 383 taken with Merck, the references by Inazuka et al. (1982a), Watanabe et al., US 4,379,168 (Dotolo), US 6,004,569 (Bessette et al) and US 5,496,857 (Targosz).

Claims are directed to a pesticidal composition consisting of a generic carrier and a pesticidally active ingredient that consists of rosemary oil and wintergreen oil. Some claims are directed to the use of equal amounts of rosemary and wintergreen oils in the composition. Some claims are further drawn to the use of carriers selected from mineral oil, benzyl alcohol, citronellal, limonene, safflower oil, soybean oil and/or sesame oil.

The cited patent DE 524 383 is relied upon as explained above. The references by Inazuka et al. and by Watanabe et al. are relied upon for the disclosure of pesticidal compositions comprising pesticidally effective amounts of either rosemary oil or wintergreen oil alone. The cited documents disclose the use of various carriers or diluents in pesticidal compositions including mineral oil (DE 524 383) or citronellal (see Watabe et al. at table II) or limonene and citronellal as components of lemon oil (DE 524 383 in view of Merck). But they are missing the particular disclosure related to the use of carriers such as benzyl alcohol, safflower oil, soybean oil and sesame oil.

However, the following documents are relied upon for the missing disclosure. For example: US 5,496,857 teaches safflower oil, soybean oil, sesame oil and also mineral oil as carriers and/or synergistic components in pesticidal mixtures (col. 2, lines 10-20, 43, 47, 55, 63 and 65). US 4,379,168 teaches benzyl alcohol and citronellal as components of pesticidal

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mixtures (col. 3, lines 40-44 and line 60; col. 4, line 35). US 6,004, 569 teaches the use of d-limonene as component of pesticidal mixtures.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to add or to substitute at least one acceptable carrier(s) into the composition of the cited DE 524 383 with a reasonable expectation of success in combating pests including various insects because all components that are presently claimed have been known and used in pesticidal mixtures as acceptable carriers and/or synergistic diluents as demonstrated by the all cited references including cited documents Inazuka et al. (1982a), Watanabe et al., US 4,379,168 (Dotolo), US 6,004,569 (Besette et al) and US 5,496,857 (Targosz). It is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

Thus, the claimed invention as a whole was clearly prima facie obvious, especially in the absence of evidence to the contrary.

Thus, the claimed subject matter fails to patentably distinguish over the state art as represented by the cited references. Therefore, the claims are properly rejected under 35 USC § 103.

Response to Arguments

Applicants' arguments filed 2/21/2006 have been fully considered but they are not persuasive.

With respect to the cited DE 524383 applicants argue (response page 7 par. 2) that the cited composition include several other oils such as linseed oil, anisole, turpentine oil, lemon oil and, thus, the cited document does not disclose the specific combination as claimed. This is not convincing because these additional oils falls within the meaning of "inert" carriers that facilitate delivery of the same "active" material such as combination of rosemary oil and wintergreen oil.

With regard to claim rejection under 35 USC § 103 applicants appear to argue that the cited references do not recognize rosemary oil and wintergreen as "active" ingredients and all other components as "inert" carrier (response page 8, par. 2). This is not found convincing because all claimed ingredients have been used and/or suggested in pesticidal compositions regardless their "active" or "inert" role and/or effects. The arguments are also not found convincing because the differences between "active" and "inert" oils are uncertain as argued, as claimed and when read in the light of applicants definitions. The meaning of "active" and "inert" oils is overlapping as disclosed.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicants' arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which they think the claims present in view of the state of the art

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disclosed by the references cited. Further, they do not show how the amendments avoid such references.

No claims are allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vera Afremova whose telephone number is (571) 272-0914. The examiner can normally be reached from Monday to Friday from 9.30 am to 6.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached at (571) 272-0926.

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The fax phone number for the TC 1600 where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Vera Afremova

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April 5, 2006

A handwritten signature in black ink, appearing to read 'V. Afremova', with a long horizontal flourish extending to the right.

VERA AFREMOVA

PATENT EXAMINER